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FROM: JEFFREY A. PYLE

RE: RESPONSE TO OFFICE ACTION

FILE:

SERIAL NO. 10/134,145

Dated January 16, 2004

2000.079600/TT4739/JAP

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OFFICIAL**PATENT***Revised
#12
O.B.
4/19/04***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:
GUSTAVO MATA, ET AL

Serial No.: 10/135,145

Filed: 4/30/2002

For: AGENT REACTIVE SCHEDULING IN
AN AUTOMATED MANUFACTURING
ENVIRONMENT

Group Art Unit: 2125

Examiner: JAYPRAKASH N. GANDHI

Atty. Dkt. No.: 2000.079600/JAP

RESPONSE TO OFFICE ACTION DATED JANUARY 16, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

CERTIFICATE OF MAILING 37 CFR 1.8(d)

I hereby certify that this correspondence is being transmitted
via facsimile to: 1-703-872-8306, Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450, on April 14, 2004.

Kathryn Danas
Kathryn Danas

This paper is submitted in response to the Office Action dated January 16, 2004 ("Paper No. 10") for which the three-month date for response is April 16, 2004. It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason, the Director is authorized to deduct said fees from Advanced Micro Devices, Inc. Deposit Account No. 01-0365/TT4739.

Reconsideration of the application is respectfully requested.

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REMARKS

Claims 1-53 are pending in the case, each having been originally filed. Paper No. 10 rejected each of claims 1-53. More particularly, Paper No. 10 rejected:

claims 1-32 as indefinite under 35 U.S.C. § 112, ¶ 2; and

claims 1-53 as anticipated under 35 U.S.C. § 102 (b) by U.S. Letters Patent 5,369,570 ("Parad").

There were no other rejections or objections. Paper No. 10 does not address the disposition of the previous rejections from the previous Office Action dated August 21, 2003. Applicants presume these rejections have been withdrawn in light of the new grounds of rejection without any affirmation of the previous rejections.

Applicants traverse each of the rejections.

I. CLAIMS 1-32 ARE DEFINITE

Paper No. 10 rejected claims 1-32 as indefinite under 35 U.S.C. § 112, ¶ 2. In particular, Paper No. 10 notes that claims 1, 12, 19 and 26 recite that the detected event be a "predetermined" event. Applicants note that independent claims 33 and 44 also recite this limitation although these claims were not rejected on this ground. Paper No. 10 alleges this limitation to be vague because "it is not understood why" the occurrence needs to be a "predetermined" one.

Applicants respectfully submit that this consideration is irrelevant to the determination of whether the claims are definite. "The test for definiteness under 35 U.S.C. 112, second paragraph is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" M.P.E.P. § 2173.02 (citation omitted). Thus, the question is

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whether one skilled in the art can understand the scope of the limitation, and not whether one skilled in the art can understand the reason for its desirability.

The Office does not allege that those skilled in the art cannot ascertain the scope of the claims reciting a "predetermined" event. The record is devoid of any evidence which would support such an allegation. Applicants therefore respectfully submit that claims 1-32 are definite and requests that the rejections be withdrawn.

II. ALL CLAIMS ARE NOVEL OVER PARAD

Paper No. 10 rejected claims 1-53 as anticipated under 35 U.S.C. § 102 (b) by U.S. Letters Patent 5,369,570 ("Parad"). An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). Office policy echoes this formulation M.P.E.P. § 2131. Applicant respectfully submits that Parad fails to meet this strict standard and that the rejections fail procedurally.

A. PARAD FAILS TO DISCLOSE ALL THE CLAIM LIMITATIONS

Each of the independent claims 1, 12, 19, 26, 33 and 44 recites a "software scheduling agent." Paper No. 10 concedes that Parad fails to disclose a software scheduling agent, but alleges that such is an "inherent property of Parad [*sic*] invention." Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1463-1464 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987).

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To inherently anticipate, it is not enough that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Oelrich*, at 326, quoting *Hansgird v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijkkaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; *see also Skinner*, at 1789. "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Skinner*, 2 U.S.P.Q.2d (BNA) at 1789.

The existence of a "software scheduling agent" does not necessarily flow from Parad's disclosure, and thus is not inherently disclosed therein. Parad expressly states at col. 7, lines 53-54 that "[t]he present invention may be implemented in any combination of software, firmware, or hardware...." Thus, even if the Office can identify some functionality, or collection of functionalities, corresponding to that of Applicants' claimed "software scheduling agent," such functionality need not necessarily be implemented in software. Parad's own disclosure establishes that such functionality could be implemented in, for example, hardware, as opposed to software.

Consequently, it does not necessarily flow that such functionality would be implemented in a "software scheduling agent", and Parad fails to inherently teach such a limitation. The Office has already conceded that Parad does not expressly teach a "software scheduling agent." Accordingly, Parad fails to anticipate any of the claims. *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1463-1464 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987).

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B. THE *PRIMA FACIE* CASE IS DEFICIENT

"It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984), quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987). "[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Where anticipation is found through inherency, the Office's burden of establishing *prima facie* anticipation includes the burden of providing "...some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987).

Applicants respectfully submit that Paper No. 10 fails to *prima facie* establish anticipation by Parad. This is most apparent with respect to the Office's reliance on the supposedly inherent teachings of Parad. As was established above, each of the independent claims recites a "software scheduling agent," which the Office concedes Parad does not teach but alleges that Parad inherently discloses. The entire treatment of this issue in Paper No. 10 is:

Parad does not positively disclose of [sic] having software-scheduling agent, but the claimed element is [an] inherent property of Parad invention.

Noticeably lacking is any semblance of any evidence or scientific reasoning as to why the disclosure of Parad inherently discloses this limitation. Since such is required by law to make the *prima facie* case, the *prima facie* case is deficient. *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987).

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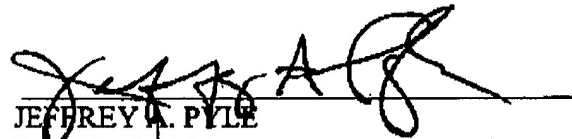
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III. CONCLUDING REMARKS

Paper No. 10 employed improper legal analyses in imposing the indefiniteness and anticipation rejections. Under legally correct analyses, the claims are neither indefinite nor anticipated. Furthermore, the improper legal analysis for anticipation fails to meet the standards necessary to *prima facie* establish any anticipation. Accordingly, Applicants respectfully submit that claims 1-59 are in condition for allowance and requests that they be allowed to issue.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,


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Date: April 14, 2004